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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/658,659	09/08/00	STANTON	V

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HM12/0420

EXAMINER

CHAKRABARTI, A

ART UNIT	PAPER NUMBER
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1655

DATE MAILED: 04/20/01

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/658,659

Applicant(s)

Stanton

Examiner
Arun Chakrabarti

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1655



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 12, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1936 O.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-193 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 17-193 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 13bis(i)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Inventor's Patent Application (PTO-152)
- 20) ☐ Other:

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Response to Amendment

1. Acknowledgment is made of applicant having filed an amendment of 12 April 2001 wherein claims 1-16 were canceled and claims 1-176 were added. As set forth in 37 CFR 1.121:

A claim canceled by amendment (not deleted and rewritten) can be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.

Accordingly, claims 1-176 have been renumbered 17-193. Please note that the dependencies of each of the claims has also been renumbered so to correspond with the renumbered claim numbers.

Sequence Rules Compliance

2. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures. Applicant must comply with the requirements of the sequence rules (37 CFR 1.821 - 1.825) before the application can be examined under 35 U.S.C. §§ 131 and 132.

Election/Restriction

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

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- I. Claims 17-26, drawn to an isolated nucleic acid comprising SEQ ID NO:1, classified in class 536, subclass 23.5; and claim 27, drawn to a method of its use, classified in class 435, subclass 6.
- II. Claims 28-37, drawn to an isolated nucleic acid comprising SEQ ID NO:2, classified in class 536, subclass 23.5; and claim 38, drawn to a method of its use, classified in class 435, subclass 6.
- III. Claims 39-48, drawn to an isolated nucleic acid comprising SEQ ID NO:3, classified in class 536, subclass 23.5; and claim 49, drawn to a methods of its use, classified in class 435, subclass 6.
- IV. Claims 50-59, drawn to an isolated nucleic acid comprising SEQ ID NO:4, classified in class 536, subclass 23.5; and claim 60, drawn to a method of its use, classified in class 435, subclass 6.
- V. Claims 61-70, drawn to an isolated nucleic acid comprising SEQ ID NO:5, classified in class 536, subclass 23.5; and claim 71, drawn to a method of its use, classified in class 435, subclass 6.
- VI. Claims 72-81, drawn to an isolated nucleic acid comprising SEQ ID NO:6, classified in class 536, subclass 23.5; and claim 82, drawn to a method of its use, classified in class 435, subclass 6.
- VII. Claims 83-92, drawn to an isolated nucleic acid comprising SEQ ID NO:7, classified in class 536, subclass 23.5; and claim 93, drawn to a method of its use,

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classified in class 435, subclass 6.

- VIII. Claims 94-103, drawn to an isolated nucleic acid comprising SEQ ID NO:8, classified in class 536, subclass 23.5; and claim 104, drawn to a method of its use, classified in class 435, subclass 6.
- IX. Claims 105-114, drawn to an isolated nucleic acid comprising SEQ ID NO:9, classified in class 536, subclass 23.5.
- X. Claims 116-125, drawn to an isolated nucleic acid comprising SEQ ID NO:10, classified in class 536, subclass 23.5; and claims 115 and 126, drawn to methods of its use, classified in class 435, subclass 6.
- XI. Claims 127-136, drawn to an isolated nucleic acid comprising SEQ ID NO:11, classified in class 536, subclass 23.5; and claim 137, drawn to a method of its use, classified in class 435, subclass 6.
- XII. Claims 138-147, drawn to an isolated nucleic acid comprising SEQ ID NO:12, classified in class 536, subclass 23.5; and claim 148, drawn to a method of its use, classified in class 435, subclass 6.
- XIII. Claims 149-158, drawn to an isolated nucleic acid comprising SEQ ID NO:13, classified in class 536, subclass 23.5; and claim 159, drawn to a method of its use, classified in class 435, subclass 6.
- XIV. Claims 160-169, drawn to an isolated nucleic acid comprising SEQ ID NO:14, classified in class 536, subclass 23.5; and claim 170, drawn to a method of its use,

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classified in class 435, subclass 6.

XV. Claims 171-181, drawn to an isolated nucleic acid comprising SEQ ID NO:15, classified in class 536, subclass 23.5; and claim 182, drawn to a method of its use, classified in class 435, subclass 6.

XVI. Claims 183-192, drawn to an isolated nucleic acid comprising SEQ ID NO:16, classified in class 536, subclass 23.5; and claim 193, drawn to a method of its use, classified in class 435, subclass 6.

4. The inventions are distinct, each from the other because of the following reasons:

Inventions I-XVI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to different compounds having different nucleotide composition and their respective methods of use.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Sequence Restriction Requirement

7. In addition, detailed above read on patentably distinct Groups drawn to multiple nucleic acid fragments and polypeptide fragments found in multiple SEQ ID Numbers. The sequences are patentably distinct because they are unrelated sequences, and a further restriction is applied to each Group. For an elected Group drawn to nucleotide sequences or cells/vectors comprising same or methods of using any of the nucleic acid fragments or polypeptide fragments, Applicants are permitted to elect a single sequences (See MPEP 803.04).

MPEP 803.04 states:

Nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq. Nevertheless, to further aid the biotechnology industry in protecting its intellectual property without creating an undue burden on the Office, the Commissioner has decided sua sponte to partially waive the requirements of 37 CFR 1.141 et seq. and permit a reasonable number of such nucleotide sequences to be claimed in a single application. See Examination of Patent Applications Containing Nucleotide Sequences, 1192 O.G. 68 (November 19, 1996).

It has been determined that normally ten sequences constitute a reasonable number for examination purposes. Accordingly, in most cases, up to ten independent and distinct nucleotide sequences will be examined in a single application without restriction. In addition to the specifically selected sequences, those sequences which are patentably indistinct from the selected sequences will also be examined. Furthermore, nucleotide sequences encoding the same protein are not considered to be independent and distinct inventions and will continue to be examined together.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arun Chakrabarti , Ph.D., whose telephone number is (703)

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306-5818. The examiner can normally be reached on 7:00 AM-4:30 PM from Monday to Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax phone number for this Group is (703) 305-7401. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0195.


Arun Chakrabarti,

Patent Examiner,

April 19, 2001


W. Gary Jones
Supervisory Patent Examiner
Technology Center 1600
4/20/01